

U.S. Application No. 09/698,550, filed October 27, 2000
Attorney Docket No. 15258US06
Supplemental Amendment dated March 30, 2009
Supplementing Amendment filed March 30, 2009

REMARKS

This Supplemental Amendment supplements the Amendment filed earlier today on March 30, 2009.

Although Applicants amended claims in the Amendment filed earlier today on March 30, 2009, Applicants do not concede that Williams, as alleged in the Office Action, describes each and every element as set forth in claims 1-4, 32 and 39-42. In addition, Applicants do not concede that Lloyd in view of Williams, as alleged in the Office Action, teaches each and every element in claims 61 and 76-93 or that Lloyd and Williams were properly combined.

Applicants do not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

Applicants reserve the right to pursue, without prejudice, subject matter that has been amended and/or cancelled in a continuing and/or related application.

Applicants have amended particular claims to expedite prosecution and to place the present application in condition for allowance as understood by the Examiner.

Applicants do not concede or admit any of the allegations as to what the combination of Williams and Lloyd, as alleged in the Office Action, describes and/or teaches.

In addition, Applicants supplements the Amendment filed earlier today on March 30, 2009 by addressing the best mode rejection under 35 U.S.C. § 112.

Applicants believe that the best mode requirement is not being applied correctly here.

Generally, the best mode requirement relates to a patentee receiving patent protection

without ever revealing his best mode.

It is logically inconsistent for the Examiner to allege that Applicants are not revealing their best mode or that Applicants are concealing their best mode, when the Examiner points to the elements of the written claims as Applicants' alleged best mode.

In other words, how can the Examiner accuse Applicants of withholding the best mode when the Examiner can see Applicants' best mode (as alleged/interpreted by the Examiner) in the claims?

M.P.E.P. § 2165.03 states that "[t]he examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. **It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution.** The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is **rarely accessible to the examiner**, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings."

The Examiner is basing a best mode rejection on the claim language provided by Applicants.

How can the Examiner allege that Applicants are concealing or withholding a best mode (as alleged/interpreted by the Examiner) when the Examiner is able to read the claimed subject matter that the Examiner is alleging is Applicants' best mode?

Does reading Applicants' claim language really constitute subject matter that is "**rarely accessible to the examiner**" as noted in M.P.E.P. § 2165.03?

U.S. Application No. 09/698,550, filed October 27, 2000
Attorney Docket No. 15258US06
Supplemental Amendment dated March 30, 2009
Supplementing Amendment filed March 30, 2009

Does reading Applicants' claim language really constitute subject matter that is **“generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings”?**

Applicants believe that the Examiner is improperly applying a best mode rejection.

The Examiner has only provided an allegation with regard to a possible objective inquiry.

As M.P.E.P. § 2165.03, the Examiner must perform a subjective inquiry and an objective inquiry. There has been at least no subjective inquiry.

M.P.E.P. § 2165.03 states that the subjective inquiry focuses on the “inventor’s state of mind at the time the application was filed”. The Examiner has not provided any “state of mind” evidence. How can the Examiner provide such subjective evidence? Has the Examiner interviewed the inventor?

Instead, it appears that the Examiner has merely focused on a possibly objective inquiry and ignored the subjective inquiry.

The Examiner is requested to closely review M.P.E.P. § 2165.03.

In view of M.P.E.P. § 2165.03, Applicants respectfully request that the Examiner withdraw the best mode rejection for at least lack of proof with respect to the subjective (not objective) inquiry as to the “inventor’s state of mind”.

Such subjective evidence is **rarely** uncovered in an *ex parte* prosecution, but might be

U.S. Application No. 09/698,550, filed October 27, 2000
Attorney Docket No. 15258US06
Supplemental Amendment dated March 30, 2009
Supplementing Amendment filed March 30, 2009

uncovered during “discovery procedures in interference, litigation, or other *inter partes* proceedings”. M.P.E.P. § 2165.03.

If the Examiner has in his possession depositions or other discovery documents from an interference, litigation or other *inter partes* proceeding, the Examiner is encouraged to use them in support of the required subjective inquiry **and** objective inquiry under M.P.E.P. § 2165.03.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: March 30, 2009

Respectfully submitted,

/Michael T. Cruz/
Michael T. Cruz
Reg. No. 44,636

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, Suite 3400
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100